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Docket: 0039-5461-2

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

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Re: Serial No.: 08/578,980  
Filed: DECEMBER 27, 1995  
Applicant: TAKANOBU KAMAKURA  
For: SEMICONDUCTOR LIGHT EMITTING DEVICE

Attached hereto for filing are the following papers:

**RESPONSE, PETITION UNDER 37 CFR §181(a)(1), & (a)(3), COPIES OF THE APPEAL  
BRIEF FILED 01/25/99, AND AMENDMENT FILED 06/09/98**

Our check in the amount of \$ - 0 - is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND  
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OFFICE OF PETITIONS

0039-5461-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

TAKANOBU KAMAKURA

SERIAL NO: 08/578,980

FILED: DECEMBER 27, 1995

FOR: SEMICONDUCTOR LIGHT  
EMITTING DEVICE

:

: GROUP: 2814

:

: EXAMINER: WILLE, D.

:



PETITION UNDER 37 CFR §1.181(a)(1) AND (a)(3)

ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

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SIR:

This is a Petition pursuant to 37 CFR §1.181(a)(1) from the Requirement mailed February 12, 2001 requiring the filing of a corrected copy of claims that were accurate and a Petition under 37 CFR §1.181(a)(3) seeking to invoke the supervisory authority of the Commissioner to direct that the examiner comply with MPEP §1003(10) and MPEP §1208.

STATEMENT OF FACTS

On January 25, 1999, Applicant filed the second Appeal Brief in this Application. This second Appeal Brief noted the following "STATUS OF AMENDMENTS" as item "IV." on page 2:

A Request for Reconsideration Under 37 CFR §1.116 was timely filed on October 26, 1998. In an Advisory Action dated November 6, 1998, the Examiner indicated that the Request had been considered but did not overcome the rejection. A Notice of Appeal was timely filed on November 24, 1998. The attached appendix reflects the claims as last amended on June 9, 1998. No amendments after final rejection have been filed or entered.

This second Appeal Brief further had attached thereto a true and accurate copy of Claims 1 and 6-10 as amended by the amendment filed on June 9, 1998. The Examiner's Answer mailed March 4, 1999, acknowledged both that the "[t]he appellant's statement of the status of amendments after final rejection in the brief is correct" (item (4) on page 2) and that "[t]he copy of the appealed claims contained in the Appendix to the brief is correct" (item (8) on page 2).

Even though over two years have elapsed since the Appeal Brief was filed and even though the Examiner's Answer acknowledged that "[t]he copy of the appealed claims contained in the Appendix to the brief is correct," a requirement was mailed on February 12, 2001 that asserts that it has now been determined that the claims provided in the Appendix to the Appeal Brief is not correct and suggests that the latest version of Claims 1 and 6-10 is not the one included as the Appendix. This requirement, mailed on February 12, 2001, seems to suggest that there was an amendment to Claims 1 and 6-10 that occurred at some unspecified time after the filing of the amendment of June 9, 1998. Applicant has no record of any such amendment being filed and the Examiner's Answer itself acknowledges that no amendments after final rejection were filed, much less entered. These facts were noted to the Examiner in the response filed on March 12, 2001 along with attached copies of the Appeal Brief (having a filing date of January 25, 1999 as indicated by Appellant's filing receipt and not the January 28, 1999 date noted in the requirement).

On March 8, 2000, Appellant did file a request for compliance with the remand order of November 23, 1999. This Request pointed out that:

On November 23, 1999, the Board of Patent of Appeals and Interferences issued an Order remanding this application to the examiner since the application did not contain a response from the examiner "stating whether the Reply Brief has been entered, and if entered, what effect Reply Brief has

on the pending rejection.” On December 28, 1999, the examiner mailed a communication which simply stated “Receipt of Reply Brief and Request for Oral Hearing on 5/4/99 is acknowledged.” Lacking from this communication is the requirement by the Board for a statement “whether the Reply Brief has been entered, and if entered what effect the Reply Brief has on the pending rejection.”

These matters are important as the Reply Brief clearly contains a request for compliance with MPEP §1003(10) and §1208 in addition to the Request for Oral Hearing. Accordingly, Applicant believes that the examiner should properly respond to the order remanding the application and specifically state whether the Reply Brief has been entered and if entered, what effect it has on the pending rejections, particularly in light of the request for proper authorization for presenting rejections with a new interpretation and/or application of 35 U.S.C. §102 as required by MPEP §1003(10) and MPEP §1208.

In addition, it was noted that:

Should this Request for compliance be denied, applicant requests prompt notification so that an appropriate petition to invoke the supervisory authority of the Commissioner under 37 CFR §1.181(a)(3) to review the refusal to comply with the Remand Order and/or the failure to provide the authority required under MPEP §1003(10) and MPEP §1208 can be filed.

There has been no response to the Request by the United States Patent and Trademark Office (PTO).

#### POINTS FOR REVIEW

The first point for review is whether or not the examiner’s requirement for “the latest version” of Claims 1 and 6-10,” without identifying what the latest version might be or how this latest version differs from the previously indicated correct copy of claims, was proper and in accordance with PTO policy.

The second point for review is whether or not the failure of the PTO to act in a timely manner upon the Request filed March 8, 2000 is an effective denial of that Request and has provided Applicant the right to petition from this denial to have the Examiner directed by the

Commissioner to comply with the dictates of MPEP §1003(10) and §1208.

ACTION REQUESTED

In light of the above, it is respectfully requested that the Examiner be directed to specifically withdraw the outstanding requirement for “the latest version” of Claims 1 and 6-10 and to make no further requirements without identifying what the latest version might be or how this latest version differs from the previously indicated correct copy of claims of Appendix of the Appeal Brief filed January 25, 1998.

In further light of the unexplained delay in answering the Request filed March 8, 2000, it is respectfully submitted that this unexplained delay be treated as an effective denial of the requested relief and that Applicant’s petition be heard as to the failure of the examiner and PTO to comply with the dictates of MPEP §1003(10) and §1208 as set forth in the Reply Brief as follows:

1. NEW INTERPRETATION AND/OR APPLICATION OF 35 U.S.C. §102 NOT PROPERLY APPROVED UNDER MPEP §1003(10) AND MPEP §1208

Page 8 of the Answer (at lines 19 and 20) appears to finally admit that “the strain layer [27 of Scifres] cannot protect the portion of the clad layer [25] outside [of the strain layer 27].” Even though stating that this “is true,” the Answer nevertheless maintains the 35 U.S.C. §102 rejection of Claims 1, 3, and 5 under what can only be considered a clearly new interpretation and/or application of this section that permits positive claim limitations to be ignored if the examiner concludes that they are “immaterial” because the examiner believes that the prior art reference achieves at least a comparable result without use of such limitations. Here, the Answer asserts that it is only “the inner region where the active layer is that needs protection” (page 8, line 20 - page 9, line 1) and “that it is the active region that must be protected and defects in the clad region would be relatively innocuous if they didn’t migrate to the active layer (page 9, line 4) as the apparent reason that the claim limitations as to placement of the dense defect layer and its role in protecting all parts of the hetero-configuration including both clad layers can be ignored.

Thus, the new interpretation and/or application of 35 U.S.C. §102 is clearly based upon a rationale that it is no longer necessary that an applied 102 reference disclose, expressly, or under the doctrine of inherency, each and every element of the claimed invention as well as disclosing structure which

is capable of performing all recited functional limitations. Instead, the examiner's new interpretation and or application of this part of the statute permits the examiner to treat a limitation as being, in effect, not present if it is deemed to be "immaterial" because the examiner has an undocumented and subjective belief that the limitation adds nothing substantial in terms of improved performance as compared to the device of the prior art reference.

This rationale permitting a positive claim limitation to be ignored looks to appellant to be suspiciously similar to the long discredited practice of attempting to ignore claim limitations that the PTO has pronounced to be deficient under 35 U.S.C. §112. Note In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) HOLDING that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art" and MPEP §2173.06. Moreover, note In re Wilder, 166 USPQ 545, 548, (CCPA 1970) requiring that every word in a claim must be given effect. Finally, the PTO has in the past presented a similar position in In re Ratti 123 USPQ 349, 352-53 (CCPA 1959) and was informed that:

If we may extract from the foregoing what we understand to be the essence of the board's position in the matter, it is that claim 10 is not patentable, though it defines a combination which is novel over the disclosures of the references, because the claimed combination has not been shown to be any better than, or to possess any advantage over, what was known to the art.

[5][6] As was pointed out in In re Stempel, Jr., 44 CCPA 820, 241 F.2d 755, 113 USPQ 77, an applicant is entitled to a patent, under the statutes, unless one of the prohibitory provisions of the statutes applies. The statutory requirements for patentability, broadly stated, are novelty, usefulness and unobviousness, as provided in 35 U.S.C. sections 101, 102, and 103. While it is true that proof that an invention *is* better or *does* possess advantages may be persuasive of the existence of any one or all of the foregoing three requirements, and hence be indicative of patentability, Congress has not seen fit to make such proof a prerequisite to patentability (Footnote omitted).

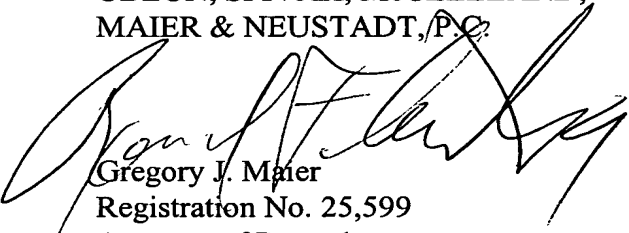
In any event, the ignoring of a claim limitation in a rejection under 35 U.S.C. §102 is a clear departure from court established criteria, as set forth, for example, by RCA Corp. v. Applied Digital Data Systems, Inc., 221 USPQ 385, 388 (Fed. Cir. 1984) (cited at page 4 of the Brief). In addition note is taken of published PTO directives in the of MPEP, such as MPEP §2131(July 1998) at page 2100-63 under the heading **"TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM"** as well as MPEP §1208(July 1998) at page 1200-17 noting the requirement that "the examiner's answer, or single prior action, shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection" (emphasis added).

Therefore, since the Answer sets forth a new interpretation and/or application of 35 U.S.C. §102, the Answer must also contain the initial Group Director approval indicated at Pages 1200-15 and 16 of MPEP §1208(July 1998) as to this "new interpretation or application of the existing patent law" under MPEP § 1003 and §1208, not to mention the required final approval noted at page 1200-16 of MPEP §1208(July 1998) relative to the Office of the Deputy Assistant Commissioner for Patent Policy and Projects. Verification of these approvals which are not apparent on the record is, therefore, requested.

If the failure to respond to the Request filed March 8, 2000, is not treated as a denial thereof, then Applicant requests the Commissioner to direct the examiner to promptly answer the Request.

Respectfully submitted,

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Attorney of Record  
Raymond F. Cardillo, Jr.  
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U.S.&M. File No. 0039-5461-2 By GJM/RFC/Imp

Serial No. 08/578,980

In the Matter of the Application of TAKANOBU KAMAKURA

For SEMICONDUCTOR LIGHT EMITTING DEVICE

The following has been received in the U.S. Patent Office on the date stamped hereon:

☐ \_\_\_ pps. Specification & \_\_\_ Claims/Drawings \_\_\_ Sheet(s)

☐ Combined Declaration, Petition & Power of Attorney (\_\_\_ pages)

☐ List of Inventor Names and Addresses

☐ Rule 60 Application;

☐ Rule 62 Application

☐ Notice of Priority;

☐ Priority Doc. ( )

☒ Check for \$ 110.00 ;

☒ Dep. Acct. Form

☐ Assignment \_\_\_ pages/PTO-1595

☐ Letter to Official Draftsman

☐ Letter Requesting Approval of Drawing Changes

☐ Drawings \_\_\_ sheets

☒ Letter Cover

☒ Amendment

☐ Information Disclosure Statement ☐ PTO-1449

☐ Cited Reference(s) ( )

☐ \_\_\_ Search Report

☐ IDS/Related / List of Related Cases

☐ Restriction Response

☐ Election of Species Response

☐ Notice of Appeal

☒ Petition for Extension of Time (one-month)

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Rev. 9/94

Due Date: 06/09/98



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OSMM&N File No. 0039-5461-2  
Serial No. 08/578,980

Dept: E/M

By: GJM/RFC/jmm

In the matter of the Application of: **TAKANOBU KAMAKURA**  
For: **SEMICONDUCTOR LIGHT EMITTING DEVICE**

The following has been received in the U.S. Patent Office on the date stamped hereon:

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| <input type="checkbox"/> pp. Specification &                                | <input type="checkbox"/> Claims/Drawings                  | <input type="checkbox"/> Sheets |
| <input type="checkbox"/> Combined Declaration, Petition & Power of Attorney | <input type="checkbox"/> pages                            |                                 |
| <input checked="" type="checkbox"/> List of Inventor Names and Addresses    |   |                                 |
| <input type="checkbox"/> Utility Patent Application                         | <input type="checkbox"/> OCPA                             |                                 |
| <input type="checkbox"/> Notice of Priority                                 | <input type="checkbox"/> Priority Doc                     |                                 |
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| <input type="checkbox"/> Assignment   | <input type="checkbox"/> pages/PTO-1595                   |                                 |
| <input type="checkbox"/> Letter to Official Draftsman                       |   |                                 |
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| <input type="checkbox"/> Search Report                                      |   |                                 |
| <input type="checkbox"/> Statement of Relevancy                             |   |                                 |
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| <input type="checkbox"/> Restriction Response                               | <input type="checkbox"/> Election Response                |                                 |
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